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EXAMINER

AVELLINO, JOSEPH E

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |   |  |
|------------------------------|---------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/828,543  | <b>Applicant(s)</b><br>COSTA-REQUENA ET AL. |  |
|                              | <b>Examiner</b><br>Joseph E. Avellino | <b>Art Unit</b><br>2446                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-29 and 31-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1, 2, 5-10, 12-14, 17, 19, 22, 33, 34, 36-39 are pending. The Office acknowledges the cancellation of claims 3, 4, 15, 16, 18, 20, 21, 23-32, 35, 40 and 41.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2008 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. In light of the cancellation of claim 40, the rejection under this heading is moot.

#### ***Claim Rejections - 35 USC § 112***

4. In light of the amendments to claim 1, and the cancellation of claims 40 and 41, the Office withdraws this rejection.

#### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5-10, 12-14, 17, 19, 22, 33, 34, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara (US 2002/0132608) (cited by applicant in IDS) in view of Zehier et al. (US 2004/0136027) in view of Coussement (US 2002/0114278).

1. Referring to claim 1, Shinohara discloses a method of exchanging multimedia data between a multimedia device (i.e. terminal 20) and a network (i.e. network 60), comprising:

digitally coupling a communication device (i.e. telephone 10) to the multimedia device (Figure 1; ¶ 35);

storing, on a data store (i.e. MMS user database server 30) accessible via the network (i.e. network 60) , a profile (i.e. data) of the communications device (i.e. mobile telephone 10<sub>1-4</sub>), the profile adapted to include a description of multimedia capabilities of the multimedia device (i.e. extension of the range of formats that each of the mobile telephones can receive...the current connection of external terminal 20<sub>1</sub> to mobile telephone 10<sub>1</sub> enables the reception of not only multimedia data of format 1, but of multimedia data, media data of format 2, that includes video data of format V2. The arrows in FIG. 4 indicate that the media type is the same as the media type of format 1) (Figure 4; ¶ 39-40);

accessing the profile for purposes of formatting the multimedia data via a network entity (i.e. results of the determination as to what the receiver formats can be received) (e.g. abstract);

formatting the multimedia data (i.e. multimedia message) via the network entity (i.e. transmitting entity) based on the profile so that the data is compatible with the multimedia device (i.e. based on the determination, alter the message to conform to the format the receiver can receive) (e.g. abstract); and

exchanging the multimedia data between the multimedia device and the network via the communications device (i.e. transmission and reception of data) (e.g. abstract; ¶ 54).

Sinohara does not specifically disclose obtaining a UPnP device descriptor of a multimedia device via a UPnP network forming a user agent profile, and discovering the multimedia capabilities of the device via the UPnP network, rather that the telephone is “coupled” to the external terminal 20 and that a profile is created. In analogous art, Zehier discloses another multimedia service providing system which discloses, in a UPnP network, receiving, at a host 12, an advertisement (read: UPnP device descriptor), including multimedia capabilities, for a service 24 from a device 14, augmenting the host’s device capabilities description file 30, and publishing the new service to a particular server to be used by particular clients (Figures 1-2, refs. 42-46; ¶ 24, 29, 35). It would have been obvious to one of ordinary skill in the art to couple the terminal of Sinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in

order to allow various to utilize services provided by particular devices using a well known protocol.

Shinohara-Zehier does not explicitly disclose the particular format of the device profile, but does disclose that it conforms to the UPnP specifications (Zehier: ¶ 24). In analogous art, Coussement discloses another terminal capability determination system which discloses the profile comprises a user/agent profile (¶ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile format used in Shinohara with the profile format described in Coussement in order to provide the benefits commonly known to the use of XML, such as the ability to define values to be used in the profile, thereby tailoring the system to the user's liking.

2. Referring to claim 2, Shinohara discloses the multimedia device comprises an audio playback device (i.e. format 2 is capable of playing the media type of "audio") or a television (the Office construes any device which is capable of playing motion video a television, such as the terminal which is capable of playing a different version of video file) (Figure 4; ¶ 38-42).

3. Referring to claim 5, Shinohara-Zehier-Coussement discloses the use of a Profile-Diff header in a message sent to the data store in order to update the profile information (i.e. since Coussement discloses the use of CC/PP repository, it inherently discloses the use of a Profile-Diff header since this is defined as part of the CC/PP

exchange protocol, see Ohto et al. "CC/PP exchange protocol based on HTTP Extension Framework" W3C Note 24 June 1999) (¶ 21).

4. Referring to claim 6, Shinohara-Zehier discloses the invention as described in claim 1. Shinohara-Zehier does not explicitly disclose the particular format of the device repository. In analogous art, Coussement discloses another terminal capability determination system which discloses the use of a CC/PP repository (¶ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile repository of Shinohara with the profile repository used in Coussement in order to provide the benefits commonly known to the use of CC/PP repository, such as providing a standardized mechanism and profile format for servers to be aware of device capability information.

5. Referring to claim 7, Shinohara discloses the network entity comprises a MMSC (i.e. multimedia message service) (Figure 1; ¶ 10).

6. Referring to claim 8, Shinohara discloses the invention substantively as described in claim 1. Shinohara does not explicitly disclose that when the terminal is uncoupled from the mobile telephone, the profile is updated to remove the description of the multimedia capabilities of the multimedia device. In analogous art, Zehier discloses another device service providing system which discloses that the profile is updated when a service is unavailable to indicate that the service is no longer available (i.e.

removing a service) (¶ 34). It would have been obvious to one of ordinary skill in the art to couple the terminal of Sinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

7.

8. Referring to claims 9 and 10, Shinohara discloses the communication device comprises a wireless mobile terminal (i.e. a mobile telephone 10) (Figure 1).

9. Referring to claim 12, Shinohara discloses the invention as described above. Shinohara does not explicitly disclose the communication device is configured to act as an internet gateway for the UPnP network. In analogous art, Zehier discloses another internet multimedia device wherein the root device acts as a gateway for the UPnP network (i.e. device 14 does not connect to the network, rather goes through the host acting as a proxy) (Figure 1). It would have been obvious to one of ordinary skill in the art to couple the terminal of Sinohara with the communication device using a UPnP network as described in Zehier in order to provide an efficient method to connect various devices together in order to allow various to utilize services provided by particular devices using a well known protocol.

10. Referring to claim 13, Shinohara-Zehier discloses the invention as described in the claims above. Shinohara-Zehier does not explicitly disclose that the UPnP network



is wireless, however a wireless UPnP network is well known in the art. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for a wireless UPnP network is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Shinohara-Zehier to connect the device 14 to the host 12 via a wireless connection in order to promote roaming and the ability for the mobile user of Shinohara to freely move about without connecting to a network via a wired connection.

11. Claims 14, 17, 19, 22, 33, 34, 36-39 are rejected for similar reasons as stated above.

### ***Response to Arguments***

12. Applicant's arguments filed April 17, 2008 have been fully considered but they are not persuasive.

Applicant argues, in substance, that Sinohara-Zehier do not disclose the use of a UPnP device descriptor to form a user agent profile usable for formatting multimedia message service data. The Examiner agrees. As shown above, it is the combination of Sinohara-Zehier as applied in the previous form of the claim, when combined with Coussement's recitation of a user agent profile, clearly meets the claimed invention. Applicant should be reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As such, the rejection is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph E. Avellino/  
Primary Examiner, Art Unit 2446

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